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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/726,564	12/01/2000	Yoshiya Nonaka	P107156-00031	1817
4372	7590	07/17/2007		
ARENT FOX PLLC 1050 CONNECTICUT AVENUE, N.W. SUITE 400 WASHINGTON, DC 20036			EXAMINER TRAN, ELLEN C	
			ART UNIT 2134	PAPER NUMBER
			MAIL DATE 07/17/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

09/726,564

Applicant(s)

NONAKA ET AL.

Examiner

Ellen C. Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☒ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☒ Certified copies of the priority documents have been received in Application No. 09/726,564.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.



### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### ***DETAILED ACTION***

1. This action is responsive to communication: 20 April 2007 with acknowledgement of an original application filed on 1 December 2000 with recognition of a foreign priority date of 8 December 1999.

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3 May 2007 has been entered.

3. Claims 1-6 are currently pending in this application. Claims 1, 3, and 5 are independent claims. Claims 1, 3, and 5 have been amended, amendment to the claims is accepted.

### ***Response to Arguments***

4. Applicant's arguments with respect to 1-6 have been considered but they are moot due to new grounds of rejection below necessitated by amendment.

### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The independent claims contain the phrase "recording/reading" the slash "/" between the words publish and subscribe renders the claim indefinite. Normally a slash between

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words indicates “and or”, the words “and or” is an indefinite limitation because it does not define the metes and bounds of the claims. See independent claims 1, 3, and 5 on pages 2-4.

Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. **Claims 1-6**, are rejected under 35 U.S.C. 103(a) as being unpatentable over Newell U.S. Patent No. 5,651,064 (hereinafter ‘064) in view of Downs et al. U.S. Patent No. 6,574,609 (hereinafter ‘609).

As to independent claim 1, **“A method for recording/reading information data using a first recording medium and a second recording medium each having its own identification data, said method comprising the steps of:”** is taught in ‘064 col. 2, lines 5-17;

**“reading first encrypted information data encrypted in accordance with an identification data of the first recording medium and recorded in said first recording medium”** is shown in ‘064 col. 3, lines 5-12;

**“encrypting the first encrypted information data in accordance with an identification data of the second recording medium, wherein the identification data of the second recording medium is different from the identification data of the first recording**

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**medium so as to produce second encrypted information data; recording the second encrypted information data in the second recording medium; reading the second encrypted information data from the second recording medium and decoding the second encrypted information data in accordance with the identification data of the second recording medium”** is disclosed in ‘064 col. 3, lines 43-50;

the following is not explicitly taught in ‘064: **“restoring the second encrypted information data into the first encrypted information data and recording the information data in the first recording medium, whereby the second encrypted information data recorded in the second recording medium is different from the first encrypted information data recorded in the first recording medium”** however ‘609 teaches multiple copies can be distributed utilizing Secure Containers in col. 11, lines 54 through col. 12, lines 10.

It would have been obvious to one of ordinary skill in the art at the time of the invention a system of preventing piracy of recorded media taught in ‘064 to include a means to copy encrypted information from a recordable media into another recordable media. One of ordinary skill in the art would have been motivated to perform such a modification to encourage digital content distributors to embrace digital content distribution see ‘609 (col. 3, lines 17 et seq.) “Another reason owners of digital content have been slow to embrace electronic distribution is their desire to maintain and foster existing channels of distribution. Most content owners sell through retailers. In the music market these U.S. retailers include Tower Records, Peaches, Blockbuster, Circuit City and others. Many of these retailers have Web sites that allow Internet users to makes selections over the Internet and have selections mailed to the end-user. Example music Web sites include @tower, Music Boulevard and Columbia House. The use of electronic

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distribution can remove the ability of the retail stores from differentiating themselves from each other and differentiate themselves from the content owners, especially on the Web. Therefore a need exists to provide retailers of electronic content such as pictures, games, music, programs and videos a way to differentiate themselves from each other and the content owners when selling music through electronic distribution”.

**As to dependent claim 2, “wherein mutual confirmation is performed between the first recording medium and the second recording medium to confirm whether these recording mediums are formally registered, an encrypted information data is read out from the first recording medium or the second recording medium if the mutual confirmation shows that the first and second recording mediums are formally registered”** is taught in ‘064 col. 3, lines 65-67 (“confirmation” same as “polling”).

**As to independent claim 3**, this claim is directed to a system executing the method of claim 1; therefore it is rejected along similar rationale. Note the identification code utilized with a matching encryption key is taught in ‘064 col. 3, lines 43-50. The ability to transfer protected copy from one encrypted media to another media where the data is also encrypted is taught in ‘609.

**As to independent claim 5**, this claim is directed to a system executing the method of claim 1; therefore it is rejected along similar rationale. Note the identification code utilized with a matching encryption key is taught in ‘064 col. 3, lines 43-50. The ability to transfer protected copy from one encrypted media to another is taught in ‘609.

**As to dependent claims 4 and 6**, these claims are substantially similar to claim 2 and they are rejected along the same rationale.

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***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ellen C Tran whose telephone number is (571) 272-3842. The examiner can normally be reached from 6:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Zand can be reached on (571) 272-3811. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Ellen Tran  
Patent Examiner  
Technology Center 2134  
7 July 2007